

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed April 7, 2005. The Examiner has required Applicants to elect to prosecute one of four groups of claims identified in the Office Action. In response to the restriction requirement, Applicants respectfully elect to prosecute the claims of Group I, corresponding to claims 1-9, with traverse, as set out hereafter.

Applicants also amend claim 1 in this response, withdraw claims 10-13 and 20-24, and add claim 25. Claims 14-19 remain pending at this time in view of Applicants' traversal of the restriction requirement below. Accordingly, claims 1-9, 14-19, and 25 are currently pending.

Regarding the restriction requirement, Applicants, in the interests of equity and fairness, should be entitled to pursue different types of claims in the present application. Specifically, Applicants should be permitted to pursue apparatus claims and method claims to fully protect the invention, as there are different bodies of law pertaining to these different types of claims. The restriction requirement is therefore unfair to Applicants because it will require Applicants to file and bear the additional cost and time delay associated with filing one or more divisional or continuing applications in order to cover each type of claim set.

Furthermore, as provided in 35 U.S.C. § 121, restriction to one of two or more claimed inventions is proper only if the inventions are "independent and distinct." In its discussion of the propriety of restrictions, MPEP § 803 further provides that if search and examination of two or more inventions can be made without "serious burden," the Examiner must examine them on the merits even if the claims are directed to distinct or independent inventions.

In the present case, Groups I and III, although not obvious in view of each other, are similar in subject matter. More specifically, each group pertains to a magnetic inductor core. For this

reason, Applicants respectfully submit that the inventions described in these claims are not “independent,” as defined in MPEP § 803, and that the restriction requirement therefore is improper as between Groups I and III.

Applicants submit that the Office Action does not depict the separate utility between the claims of Group I and the claims of Group III. While any two separate claims of a patent have some degree of separate utility, claims 1 and 14 of Groups I and III, respectively, do not have such separate utility so as to preclude these method and apparatus claims from being pursued in the same patent application. Plus, to further clarify that claim 1 is directed to a magnetic inductor core, the preamble has been amended, which makes this method claim preamble similar to the apparatus claim preamble of claim 14. Additionally, the method steps of claim 1, while different from the recited elements of claim 14, are directed to similar subject matter. Consequently, the claims of Group III should be considered with the claims of Group I.


Applicants also respectfully disagree with the proposition in the Office Action suggesting that Groups I and III are distinct as having acquired different classifications. Specifically, the Office Action suggests that Group I, including claims 1-9, is classified in class 29, subclass 609; while Group III, including claims 14-19, is classified in class 339, subclass 234. For the claims of Group I, the designated class 29 pertains to the generic class of metal working or shaping. Subclass 609 more specifically pertains to a method of mechanical manufacturing (subclass 592) laminated electromagnet inductors (subclass 602.1). For the claims of Group III, the designated class 336 pertains to the generic class for the structure of inductor devices. Subclass 234 specifically pertains to a laminated (234) inductor core (subclass 233).

Both of these classifications (29/609 & 339/234) focus on laminated inductors. The claims themselves are directed to magnetic inductor cores. One group pertains to the method of

manufacturing the core while the other group relates to the composition of the core itself. While the independent claims in each of Groups I and III are not identical or obvious, they do bear similarities. Plus, just because these claim groups may be classified in the respective classes noted in the Office Action, that does not preclude additional overlapping classifications, which means that the Patent and Trademark Office is not placed under a "serious burden" of searching an exorbitant number of classes. Accordingly, Applicants respectfully request that the restriction against claims 14-19 of Group III be removed so that these claims may become part of Group I with claims 1-9.

For at least the foregoing reasons, Applicants respectfully traverse the restriction requirement and respectfully requests the Examiner to examine the claims of Groups I and III together. Applicants expressly reserve the right to present the non-elected claims, or variants thereof, in continuing applications to be filed subsequent to the present application. Should the Examiner have any questions regarding this response, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,



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